



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/973,056      | 10/10/2001  | Michihiro Izumi      | 35.C15861           | 5038             |

5514 7590 03/28/2006

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

|          |
|----------|
| EXAMINER |
|----------|

RAMAKRISHNAIAH, MELUR

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2614

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/973,056

Applicant(s)

IZUMI ET AL.

Examiner

Melur Ramakrishnaiah

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-16-2006 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 22, 24, 25, are rejected under 35 U.S.C (102b) as being anticipated by Yasumoto et al. (JP 10-042068, hereinafter Yasumoto).

Regarding claim 22, Yasumoto discloses a communication apparatus including means for connecting to a public communication line, a scanner for reading an image, means for converting the image read by the scanner to have a predetermined format, and means for executing a sending process to a server connected to the communication line in a case where it is necessary to send the converted image as an electronic mail, the apparatus comprising: means (5, Drawing 1) for registering a facsimile number of a destination for an abbreviation number, means (5, Drawing 1) for registering an electronic mail address for the same abbreviation number, a key

Art Unit: 2614

corresponding to the abbreviation number, a key representing facsimile sending, and a key representing electronic mail sending, means (11, Drawing 1) for executing the facsimile sending of the read image to the registered facsimile number in a case where the key representing the facsimile sending is depressed pursuant to the abbreviation number, means (6, Drawing 1) for executing the electronic mail sending of the read image to the registered electronic mail address in a case where the key representing the electronic mail sending is depressed pursuant the abbreviation telephone number, wherein the public communication line (L1, Drawing 1) is a digital communication line capable of simultaneously executing plural communications, and wherein apparatus comprises means (1, Drawing 1) for executing the facsimile sending of the read image to the registered facsimile number by using a first communication channel (for example L2, Drawing 1), and means (1, Drawing 1) for executing the electronic mail sending of the read image to the registered electronic mail address by using a second communication channel (for example L1, Drawing 1), in a case where the key representing the facsimile sending and the key representing the electronic mail sending are depressed to the abbreviation number (abstract: paragraphs: 0008-0038).

Claims 24-25 are rejected on the same basis as rejection of claim 22.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yasumoto in view of Matsubara et al. (US PAT: 6,545,768, filed 5-20-1998) and Yamamoto (US PAT: 5,033,859).

Yasumoto differs from claim 23 in that he does not teach simultaneously executing plural communications, and there is prepared a key representing simultaneous sending of the facsimile and the electronic mail in case where the key representing the simultaneous sending is depressed.

However, Matsubara teaches sending image data of the document simultaneously through the first and second networks (col. 2 lines 16-20) and Yamamoto discloses simultaneous transmission key (8, fig. 1) for transmission of facsimile to subscribers by operation of simultaneous transmission key (col. 4 lines 5-12).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Yasumoto's system to provide for the following: simultaneously executing plural communications, and there is prepared a key representing simultaneous sending of the facsimile and the electronic mail in case where the key representing the simultaneous sending is depressed as this arrangement would provide simplified user interface for effecting simultaneous transmission of facsimile data as taught by the combination of Matsubara and Yamamoto.

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yasumoto in view of Kanda et al. (JP357174971A, hereinafter Kanda).

Yasumoto differs from claim 26 in that although he discloses a first CPU (1, Drawing 1) detecting the key representing the electronic mail is depressed and means for forming and sending the electronic mail (paragraphs: 31-32); he does not specifically teach the following; means for notifying the a second CPU that the first CPU executed the detection, and means for sending electronic mail when the second CPU receives the notification.

However, it is well known in the art to use two CPU to control processing in a facsimile machine (see abstract of Kanda).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Yasumoto's system to provide for the following: means for notifying the a second CPU that the first CPU executed the detection, and means for sending electronic mail when the second CPU receives the notification as this arrangement would give one method, among many possible methods, for arranging control processing in a facsimile machine for transmission data.

### ***Response to Arguments***

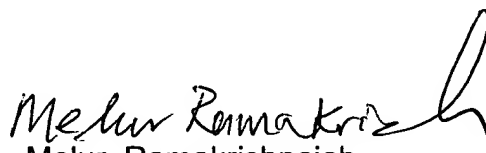
7. Applicant's arguments with respect to claims 22-26 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

Art Unit: 2614

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Melur Ramakrishnaiah  
Primary Examiner  
Art Unit 2614